

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 2, 4, 10, 12, 14, 15, 16, 45, 46, 52, 54, 55, 56, 57, 59, and 60 are pending in the application, with claims 1 and 2 being the independent claims. Claims 3, 5-9, 11, 13, 18-33, 35-44, 47-51, 53, and 58 are sought to be canceled without prejudice to or disclaimer of the subject matter therein. New claims 59 and 60 are sought to be added.

Support for the amendments to the claims and the new claims can be found throughout the specification and in the claims as originally filed. In particular, support for the amendment to claim 14 can be found, *inter alia*, in claims 10, 12, and 14 as originally filed. Support for the amendment to claim 15 can be found, *inter alia*, in claims 10, 12, and 15 as originally filed. Support for the amendment to claim 16 can be found, *inter alia*, in claims 10 and 16 as originally filed. Support for the amendment to claim 45 can be found, *inter alia*, in claims 38, 44, and 45 as originally filed. Support for the amendment to claim 46 can be found, *inter alia*, in claims 38 and 46 as originally filed. Support for the amendment to claim 52 can be found, *inter alia*, in claims 48 and 52 as originally filed. Support for the amendment to claim 54 can be found, *inter alia*, in claim 54 as originally filed. Support for the amendment to claim 55 can be found, *inter alia*, in claim 55 as originally filed. Support for the amendment to claim 56 can be found, *inter alia*, in claim 56 as originally filed. Support for the amendment to claim 57 can be found, *inter alia*, in claim 57 as originally filed. Support for new claim 59 can be

found, *inter alia*, in claims 39, 44, and 45 as originally filed. Support for new claim 60 can be found, *inter alia*, in claims 39 and 46 as originally filed.

These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejection under 35 U.S.C. § 112***

The Examiner rejected claims 3, 5, and 33 under 35 U.S.C. § 112 ¶ 1 for lack of enablement. Applicants have canceled claims 3, 5, and 33. Accordingly, the Examiner's rejection of claims 3, 5, and 33 under 35 U.S.C. § 112 ¶ 1 has been rendered moot.

***Rejoinder under In re Ochiai***

Applicants note that claim 1 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claims 10, 14 (as amended), 15 (as amended), and 16 (as amended) of Groups IV and V of Paper No. 10, drawn to a method for treating or preventing cancer comprising administering the tumor-associated antigen of claim 1, are related as between a product (Group I) and a process for using the product (Groups IV and V).

Applicants further note that claim 1 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claims 12, 14 (as amended), and 15 (as amended) of Groups VI and VII of Paper No. 10, drawn to a method of treating or preventing

cancer comprising incubating CLTs with antigen presenting cells and the tumor-associated antigen of claim 1, are related as between a product (Group I) and a process for using the product (Groups VI and VII).

Applicants further note that claim 1 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 45 (as amended), which, according to the Examiner, is allegedly in Groups XIX and XX of Paper No. 10, drawn to a method of producing a protein comprising growing a recombinant cell containing a recombinant nucleic acid vector comprising a nucleotide sequence encoding a protein or protein fragment, such that the protein or protein fragment is expressed by the cell, wherein said protein or protein fragment displays one or more functional activities of the tumor-associated antigen of claim 1, are related as between a product (Group I) and a process for making the product (claim 45).

Applicants further note that claim 1 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 46 (as amended) of Groups XXII and XXV of Paper No. 10, drawn to a method for treating or preventing cancer comprising administering to an individual an amount of a nucleic acid comprising a nucleotide sequence encoding a protein or protein fragment, wherein said protein or protein fragment displays one or more functional activities of the tumor-associated antigen of claim 1, are related as between a product (Group I) and process for using the product (Groups XXII and XXV).

Applicants further note that claim 1 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 52 (as amended) of Groups XXX and XXXII of Paper No. 10, drawn to a method for treating or preventing cancer comprising

administering an antibody which binds to the tumor-associated antigen of claim 1, are related as between a product (Group I) and process for using the product (Groups XXX and XXXII).

Applicants further note that claims 1 and 2 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 54 (as amended) of Groups XXXIV and XXXVIII of Paper No. 10, drawn to a method of diagnosing or screening for cancer comprising detecting or measuring in a sample derived from an individual the level of the tumor-associated antigen of claim 1 or claim 2, are related as between a product (Group I) and a process for using the product (Groups XXXIV and XXXVIII).

Applicants further note that claims 1 and 2 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 55 (as amended) of Groups XXXIV and XXVI of Paper No. 10, drawn to a method for detecting tumor cells that express the tumor-associated antigen of claim 1 or claim 2, are related as between a product (Group I) and a process for using the product (Groups XXXIV and XXVI).

Applicants further note that claims 1 and 2 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 56 (as amended) of Group XXXIV of Paper No. 10, drawn to the method of claim 55, wherein the labeled molecule is an antibody or a portion of said antibody containing the binding domain thereof which binds to a polypeptide comprising the amino acid sequence of SEQ ID NO:2, are related as between a product (Group I) and a process for using the product (Group XXXIV).

Applicants further note that claims 1 and 2 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and claim 57 (as amended) of Group XXXVI of Paper No. 10, drawn to the method of claim 55 wherein the labeled molecule is a

polypeptide comprising the amino acid sequence of SEQ ID NO:2, are related as between a product (Group I) and a process for using the product (Group XXXVI).

Applicants further note that claim 2 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and new claim 59, drawn to a method of producing a protein comprising growing a recombinant cell containing a recombinant nucleic acid vector comprising a nucleotide sequence encoding the tumor-associated antigen of claim 2, such that a tumor-associated antigen protein is expressed by the cell, are related as between a product (Group I) and a process for making the product (new claim 59).

Applicants further note that claim 2 of Group I of Paper No. 10, drawn to the recited tumor-associated antigen, and new claim 60, drawn to a method for treating or preventing cancer comprising administering to an individual a therapeutic or prophylactic amount of a nucleic acid comprising a nucleotide sequence encoding the tumor-associated antigen of claim 2, are related as between a product (Group I) and a process for using the product (new claim 60).

In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that

in the case of an elected product claim, *rejoinder will be permitted when a product claim is found allowable* and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

*Id.* (emphasis added). Therefore, Applicants submit that claims 10, 12, 14, 15, 16, 45, 46, 52, 54, 55, 56, and 57, as well as new claims 59 and 60, depend from or include all the limitations of one or more claims of Group I of Paper No. 10. The Examiner has allowed product claims 1, 2, and 4 of Group I. Accordingly, Applicants hereby rejoin claims 10, 12, 14, 15, 16, 45, 46, 52, 54, 55, 56, and 57, as well as new claims 59 and 60, and respectfully request the Examiner to examine claims 10, 12, 14, 15, 16, 45, 46, 52, 54, 55, 56, and 57, as well as new claims 59 and 60, for patentability based on the reasons discussed above.

#### ***Other Matters***

Applicants respectfully request that the Examiner acknowledge Applicants' priority claim to German priority patent application number DE 199 36 563.6 under 35 U.S.C. § 119(a)-(d). 35 U.S.C. § 119(a)-(d) (2003). The foreign filing date of DE 199 36 563.6 is August 4, 1999.

The requirements for making a foreign priority claim for applications filed prior to November 29, 2000 are: 1) the applicant must file a claim for the right; and 2) the applicant must file a certified copy of the original foreign application. M.P.E.P. § 201.14 at 200-86 (8<sup>th</sup> ed. August 2001).

Applicants clearly made a foreign priority claim to DE 199 36 563.6 in Applicants' unexecuted Declaration for Utility or Design Patent Application filed on August 3, 2000. In addition, Applicants clearly made a foreign priority claim to DE 199 36 563.6 in Applicants' executed Declaration for Utility or Design Patent Application

filed on January 30, 2001 in response to the Notice to File Missing Parts of Nonprovisional Application mailed on October 23, 2000.

Regarding the filing of a certified copy of priority document DE 199 36 563.6, Applicants point out that certified priority document DE 199 36 563.6 is in Applicants' instant patent application on file with the USPTO, in compliance with M.P.E.P. § 201.14(b). *See* M.P.E.P. § 201.14(b) at 200-90 (8<sup>th</sup> ed. August 2001). Applicants' unexecuted Declaration, filed with the instant nonprovisional application on August 3, 2000, indicates on page one (1) that a certified copy of DE 199 36 563.6 had been attached to the unexecuted Declaration. Furthermore, Applicants' filing postcard dated August 3, 2000, which was date-stamped by the USPTO, indicates that a Priority Document had been filed with the instant nonprovisional application on August 3, 2000.

Therefore, Applicants respectfully request that the Examiner acknowledge Applicants' priority claim to German priority patent application number DE 199 36 563.6 under 35 U.S.C. 35 U.S.C. § 119(a)-(d).

***Conclusion***

All of the stated grounds of objection and rejection have been properly rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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